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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,482	11/10/2003	John A. Benaglio	7334-0003-2	5153
27735	7590	06/29/2004	EXAMINER	
WILLIAM C. CRUTCHER MCCORMICK, PAULDING & HUBER, LLP 185 ASYLUM STREET, CITY PLACE II, 18TH FLOOR HARTFORD, CT 06103-4102			MICHENER, JENNIFER KOLB	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*g*

## Office Action Summary

Application No.

10/705,482

Applicant(s)

BENAGLIO ET AL.

Examiner

Jennifer K. Michener

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pattantyus-Abraham et al. (6,325,198).

Pattantyus-Abraham teaches a high-speed manufacturing method for making battery cans, which qualify as "drawn metal parts", in an improved method over the prior art "bulk" method (abstract; col. 1). The battery cans are provided in a single order stream with a sequential order (see Figures; col. 32, lines 25-35). The stream of cans are moved with intermittent motion having move times and dwell times wherein process operations are performed during the dwell time (col. 3, lines 30-40; col. 21, lines 35-40).

One of the process module operations of Pattantyus-Abraham is coating the internal surface of the can (col. 23, lines 15-30) with an application head (Fig. 44), which appears to be a spray gun as there is no contact between the can and the applicator.

The firing/coating rate of Pattantyus-Abraham appears to be "normal". Finally, Pattantyus-Abraham teaches inspection and testing of the cans (col. 2, line 38; col. 9, line 29). While he does not specifically teach inspection and testing of the coating of the can, it is Examiner's position that it would have been obvious to inspect the quality of all critical elements of the can prior to selling the product, including the coating quality.

Since inspection would be difficult while the cans are moving and since Pattantyus-Abraham teaches a programmed sequence of dwell periods (col. 23, line 64), it would have been obvious to an ordinary artisan to inspect the quality of the cans during a dwell period instead of during a motion period.

What Pattantyus-Abraham fails to specifically state in regards to claim 1 is the presence of a plurality of coating guns. However, Examiner notes that the Figures and

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specification of Pattantyus-Abraham indicate a plurality of process modules. Since coating is one of Pattantyus-Abraham's process modules and a plurality of cans are being processed (and therefore coated) simultaneously, it would appear that a plurality of coating guns would be required in the method of Pattantyus-Abraham. However, in the absence of such a specific teaching, Examiner notes that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 124 USPQ 378 (CCPA 1960).

Lastly, Examiner notes that only one coating applicator is used in the method of claim 1. Therefore the presence of additional, non-used applicators would not be a novel element of the claim.

Regarding limitations of claim 5, not addressed above, requiring shutting down coating guns which are producing defective coatings, Examiner notes that an ordinary artisan or engineer working in a manufacturing process would have found it obvious to discontinue use of a malfunctioning part in order to prevent the loss of profits associated with the continued defective production of parts. Due to Pattantyus-Abraham's ordered sequence and tracking system (col. 32), it would be evident which coating applicator was defective. Short of shutting down the entire process, use of a second, functioning coating applicator would have been obvious to an ordinary artisan to save shut-down costs.

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Regarding claim 2, as stated above, the use of a second coating applicator would have been obvious in the simultaneous processing of a plurality of cans in the method of Pattantyus-Abraham.

Regarding claims 3-4 and 6-7, selection of a firing speed for coating application would have been determined based on the time for process throughput and the number of applicators available for coating each can. It would have been within the skill of an ordinary artisan to select a coating speed to achieve optimized results.

It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Regarding the limitations of claims 4 and 7, not addressed above, Examiner notes that the applicator of Pattantyus-Abraham is "fixed", however, it is Examiner's position that an applicator that can move relative to a coating object would have been obvious to provide access to a part to be coated. Since Pattantyus-Abraham teaches moving the parts on a conveyor relative to the sprayer and since all movement is relative, the movement of the sprayer relative to the part is equivalent to moving the part relative to the conveyor.

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**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K. Michener whose telephone number is (571) 272-1424. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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June 26, 2004